

REMARKS

Reconsideration of the present application is requested on the basis of the following particulars.

1. Election Requirement

In reference to the provisional election made on November 1, 2004, Applicants hereby formally elect the prosecution of the invention of Group I comprising originally-filed claims 1-10.

2. In the Specification

The specification is amended to clarify the description of a plurality of adjustable cam followers.

It is well understood that a patentee can claim subject matter broader than the preferred embodiments described in the specification. *See Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 1328 (Fed. Cir. 2001). In the present instance, while claim 6 recites that there are “two” adjustable cam followers, the specification does not limit the invention to an embodiment wherein there can only be one adjustable cam follower as intimated by the examiner in the office action. More specifically, the specification indicates that there can be at least one adjustable cam follower (paragraph 0039). As such, the specification clearly allows for an embodiment and, hence a claim wherein there are a plurality of adjustable cam followers.

In order to expedite the prosecution of the pending application, applicants have agreed to amend the application to indicate that the embodiments described in the specification include a plurality of adjustable cam followers. More particularly, the specification in paragraph [0039] now indicates that FIGS. 5 and 7, which show opposite sides of the deck carriage 80, illustrate an adjustable cam follower 68 located on each side of the deck carriage.

The new description is not considered to constitute new matter since the originally-filed drawings clearly show that there is an adjustable cam follower on each side of the deck carriage. Moreover, the originally-filed specification also makes clear reference to “at least one adjustable cam follower” which does not limit the specification in describing only one adjustable cam follower.

Acceptance of the amendment of the specification and removal of the objection to the specification is respectfully requested in the next office communication.

3. In the Drawings

The drawings are not amended in view of the objection thereof in the office action. As mentioned above in reference to the specification, it is asserted that the drawings show in FIGS. 5 and 7 opposite sides of the carriage deck wherein an adjustable cam follower 68 is provided on each side of the carriage deck.

Applicants respectfully disagree with the examiner’s assertion that the specification only explicitly teaches one cam follower. It is readily evident that the specification indicates that “at least” one cam follower is provided (see paragraph [0039]). The language “at least one” does not limit the specification to only one adjustable cam follower. Indeed, it is maintained that FIGS. 5 and 7 show different sides of the carriage deck and different adjustable cam followers.

In view of these comments, withdrawal of the rejection of the drawings is respectfully requested.

4. In the Claims

In the amendment of the claims, claims 1, 5, 6, 8 and 9 are currently amended, new claims 13-17 are submitted, and claims 11 and 12 are canceled.

a. Amendment of Claims 1, 5, 6 and 8

Claim 1 is amended to recite the subject matter provided in paragraph [0027] wherein the track member is “sufficiently flexible to permit bending thereof to generally conform to a geometrical portion of a workpiece.”

Claims 5, 6 and 8 were rejected under 35 U.S.C. § 112, second paragraph for lacking definiteness. These claims are currently amended and it is submitted that their amendments overcome the indefiniteness rejection and do not narrow the scope of these claims.

Claim 5 is amended to correct the informalities identified in the office action regarding the term “distal” which was replaced with the term “first.” Moreover, proper antecedent basis is provided for the “pin elements,” and the “bearing assemblies.”

Claim 6 is amended to provide proper antecedent basis for “the carriage deck” by changing its dependency to claim “5” from claim “4.”

Claim 8 is amended to provide proper antecedent basis for the “carriage assembly” and the “feed screw.” Moreover, the displacement of the motion of the cutting tool assembly is clarified so that it travels along “its longitudinal axis” due to rotation of the feed screw.

In view of the amendment of claims 5, 6 and 8, it is respectfully requested that the rejection of claims 5, 6 and 8 be withdrawn since these claims are now believed to comply with 35 U.S.C. § 112, second paragraph.

b. New Claims 13-17

New claim 13 recites that the track member consists a single, elongate solid body. This claim finds specific support in FIGS. 2 and 3 and in paragraph [0027] of the specification.

New claim 14 recites that the track member has generally planar top and bottom surfaces. This claim finds the same support as claim 13.

New claim 15 recites that the track member comprises a solid and generally rectangular cross-section. This claim finds the same support as claim 13.

New claim 16 is a combination of original claim 1 and currently amended claim 5. Since claim 5 was indicated as reciting allowable subject matter in the office action, it is submitted that new claim 16 is allowable.

New claim 17 is a combination of original claim 1 and currently amended claim 8. Since claim 8 was indicated as reciting allowable subject matter in the office action, it is submitted that new claim 17 is allowable.

Entry and allowance of the new claims is respectfully requested in the next office communication.

c. Cancellation of Claims 11 and 12

Claims 11 and 12 are currently canceled without prejudice or disclaimer.

5. Rejection of Claims 1-4, 6-7 and 9-10 Under 35 U.S.C. § 102(b) as Being Anticipated by U.S. Patent 4,297,061 (Wolfe et al.)

Claims 1-4, 6-7 and 9-10 are currently rejected as lacking novelty in view of the Wolfe et al. patent. This rejection is respectfully traversed in view of the amendment of claim 1 and the distinctions of the pending claims over the teachings by Wolfe et al.

Specifically, the Wolfe et al. patent describes a large-scale steam generator shell parting method and apparatus that relies on a complicated array of mounting assemblies. The mounting assemblies are rigid and preformed only to accommodate specified steam generator shells.

An example of the inflexibility of the method and apparatus of Wolfe et al. lies in the teaching of the circular track 72. This track is comprised of multiple arcuate sections of a thick-wall box beam that are bolted together at end flanges 73 while being placed in horizontal extension onto support blocks 64 atop support brackets (col. 4, lines 12-15).

Nowhere is there any disclosure or teaching of this track having the ability to accommodate workpieces of various shapes and dimensions. Wolfe et al. describe that their apparatus requires an elaborate array of screws, nuts and flanges in order for the track to be mounted onto the steam generator shells (col. 4, lines 15-27).

The Wolfe et al. patent fails to teach or disclose the simple and elegant solution of claim 1 of the pending application for providing a cutting tool and guidance system that can accommodate a variety of workpieces having various shapes and dimensions. Specifically, amended claim 1 recites that the track elements of the track members are sufficiently flexible to permit bending thereof to generally conform to a geometrical portion of a workpiece. The configuration of the track elements of claim 1 provide the advantage that they are not limited to a particular workpiece, as taught by the Wolfe et al. patent, and they can easily be mounted and dismounted from a workpiece.

The Wolfe et al. patent clearly teaches mounting assemblies that are substantially different from the track members of amended claim 1. This is readily evident in view of the specific reference to the track sections having an arcuate shape and being of a thick wall box beam construction. There is simply no disclosure by Wolfe et al. which would tend to indicate that the track sections have a form other than the specified arcuate shape to accommodate a steam generator shell.

It is submitted that the Wolfe et al. patent does not teach a cutting tool and track guidance system having track members that are sufficiently flexible to conform to a geometrical portion of a workpiece.

Withdrawal of this rejection is courteously requested.

In view of these observations, allowance of claim 1 is respectfully requested.

Claims 2-10 and new claims 13-15 are patentable based on their dependency from claim 1 and their individually recited features.

6. Rejection of Claim 6 Under 35 U.S.C. § 103(a) as Being Unpatentable over U.S. Patent 4,297,061 (Wolfe et al.)

Claim 6 depends from claim 1 and is patentable based on its dependency therefrom. Claim 1 is distinguished above in view of the teachings of the Wolfe et al. patent. In light of these observations, withdrawal of this rejection is respectfully requested.

7. Conclusion

As a result of amendments to the claims and the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-10 and 13-17 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

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